

Attorney Docket No. YOR920000581US1

REMARKS

The present application was filed on December 7, 2000 with claims 1-20. In the outstanding Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,446,136 to Pohlmann et al. (hereinafter "Pohlmann") in view of U.S. Patent No. 6,477,575 to Koeppel et al. (hereinafter "Koeppel").

In this response, Applicants traverse the §103(a) rejection of claims 1-20 based on at least the following reasons.

In the final Office Action, the Examiner contends that the previously submitted declarations were insufficient to predate the Koeppel reference. More specifically, the Examiner contends that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the reference. Applicants strongly disagree.

Applicants note that when the merits of the declaration were first considered in an Office Action dated February 17, 2005, the Examiner provided no such contention regarding insufficiency of evidence to establish conception, and only noted insufficiency of evidence regarding diligence. Thus, upon first examination of the declaration, the evidence submitted was deemed sufficient to establish a conception of the invention prior to the effective date of the reference. Since the Office Action of February 17, 2005, additional evidence has been supplied supporting conception and diligence. Thus, it is not clear how or why the Examiner's contention has changed, especially after time, efforts and financial resources of Applicants, Applicants' attorneys and the USPTO have already been attributed to the preparation and examination of the submitted declarations.

As stated in the final Office Action conception must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. As shown in paragraph 2 and exhibit 1 of the Applicants' declaration a draft application was prepared by Applicants in August 2000. Further, as shown in paragraph 2 and exhibit 1 of the Attorney Affidavit this draft application was received by Applicants' attorney on August 28, 2000. A draft application including figures and claims is clearly demonstrative evidence of conception. Further, a draft application including figures and claims far exceeds a vague idea of how to solve a problem.

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The inventor declaration, attorney affidavit and their corresponding exhibits evidence the conception of an invention falling within independent claims 1, 8 and 14 and one or more dependent claims, at least as early as August 2000, and thus prior to the September 12, 2000 effective date of Koeppel. The inventor declaration, attorney affidavit and their corresponding exhibits further evidence due diligence in the preparation of a patent application from prior to the September 12, 2000 effective date until the filing date of the U.S. patent application on December 7, 2000.

In response to all arguments previously asserted by Applicants regarding the inventor declaration, the attorney affidavit and their corresponding exhibits, the Examiner now contends in the final Office Action that "Applicants are required to support all document to map all claims [sic]." The examiner fails to provide support for such a general requirement to map all claims in the declaration. Further, Applicants assert that no such mapping is required in a declaration that relies upon a draft application, having both figures and claims, for proof of conception.

Alternatively, with regard to the rejection of claims 1-34 under 35 U.S.C. §103(a) as being unpatentable over Pohlmann in view of Koeppel, in the event that Koeppel is not removed as a reference, Applicants respectfully assert that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth therein, M.P.E.P. §2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that no motivation or suggestion exists to combine Pohlmann and Koeppel in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277

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F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id at 1343-1344.

In the final Office Action, on page 3, paragraph 1, the Examiner provides the following statement to prove motivation to combine Pohlmann and Koeppel, with emphasis supplied:

“It would have been obvious . . . to combine the teachings of Pohlmann and Koeppel to have one or more corresponding actions to the one or more automatically learn predicates to form the one or more correlation rules because it would have allowed providers to perform automatic dynamic market testing and automatically adjusted served content based on responses from users.”

Applicants submit that the statement above is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Pohlmann and Koeppel in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner’s conclusory statements do not adequately address the issue of motivation to combine references. “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

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In response to arguments previously asserted by Applicants regarding motivation to combine references, in the final Office Action the Examiner merely "recognizes" a rule for obviousness and provides no additional support or explanation for the proposed combination.

Secondly, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Pohlmann and Koepfel. For at least this reason, a prima facie case of obviousness has not been established. Applicants do not believe that Pohlmann and Koepfel are combinable since it is not clear how one would combine them. Again, no guidance was provided in the final Office Action as to how the references can be combined to achieve the present invention. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Pohlmann and Koepfel fails to suggest or render obvious at least the elements of independent claims 1, 8 and 14 of the present invention. For at least this reason, a prima facie case of obviousness has not been established.

Independent claim 1 recites a computer-based method of constructing one or more correlation rules for use by an event management system for managing a network with one or more computing devices. One or more event patterns representing event data associated with the network of computing devices being managed by the event management system are selected. Predicates of the one or more correlation rules from the one or more selected event patterns are automatically learned. One or more corresponding actions to the one or more automatically learned predicates are added to form the one or more correlation rules. Independent claims 8 and 14 recite additional embodiments of the present invention having similar limitations.

Pohlmann discloses an event management system in which an event manager provides and receives events, an event correlator correlates at least one of the events based on alarm rules, and a response engine executes a response policy based on the correlation of events by the event correlator. Koepfel discloses methods and apparatus for performing dynamic web-based market analysis.

The combination of Pohlmann and Koepfel fails to disclose the element of automatically learning predicates of the correlation rules from selected event patterns. The Examiner contends that this is provided in Pohlmann, however, the portions of Pohlmann cited by the Examiner disclose the

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querying of events and the forwarding or publishing of events matching a subscription request to the requestor. Pohlmann fails to disclose anything regarding predicates of correlation rules, or the automatic learning of such predicates from selected event patterns. Koeppel fails to remedy the deficiencies described above with regard to Pohlmann. Therefore, the combination of Pohlmann and Koeppel fails to disclose this element of the independent claims.

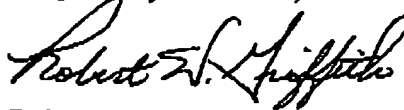
The combination of Pohlmann and Koeppel also fails to disclose the element of adding corresponding actions to the automatically learned predicates to form correlation rules. The Examiner contends that this element is provided in Koeppel, however, the portions of Koeppel cited by the Examiner disclose the automatic update of content rules through an analysis of user response data. Koeppel fails to disclose anything regarding the addition of corresponding actions to automatically learned predicates to form correlation rules. Pohlmann fails to remedy the deficiencies described above with regard to Koeppel. Therefore, the combination of Pohlmann and Koeppel fails to disclose this element of the independent claims.

In response to arguments previously asserted by Applicants regarding the elements above, in the final Office Action the Examiner simply maintains that these elements are clearly shown without any further support or explanation.

Dependent claims 2-7, 9-13 and 15-20 are patentable at least by virtue of their respective dependency from independent claims 1, 8 and 14, and also recite patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-20 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejection.

Respectfully submitted,



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